

## **REMARKS**

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

In the Office Action, claims 17-31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,862,322 to Ewen et al. ("Ewen"). By this Amendment, claims 31 and 33 are amended, and new claims 34 and 35 are added. No new matter has been added. Support for new claims 34 and 35 can be found, for example, at page 3 of the specification. Applicant notes that the amendment herein to claims 31 and 33 have not been made in response to any rejection or objection posed by the Examiner, but rather simply to refine the language of that claim. In this regard, it should be noted that Applicant has broad discretion to choose and modify the language of a claim and, moreover, various patentable expressions of comparable claim scope lie within the bounds of such discretion. Because the amendment to claims 31 and 33 falls within the bounds of that discretion, such amendment is not related to patentability of that claim.

### **Rejection Under 35 U.S.C. § 103**

Applicant traverses the rejection of claims 17-31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Ewen for at least the reason that the Office Action fails to establish a *prima facie* case of obviousness. Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143. Additionally, as cited in M.P.E.P. § 2143.01 “‘There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.’ *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) ... The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).”

With respect to claim 17, the Office Action has failed to establish that Ewen discloses or suggests at least “wherein at least one of the at least two gain values is optimized for maximum sensitivity.” The Office Action agrees that “Ewen fails to specifically teach that at least one of the at least two gain values is optimized for maximum sensitivity.” *Office Action* at 2. Ewen merely discloses “a switchable transimpedance element” allowing the gain to be changed. Col. 6, lines 3-19. Ewen simply contains no discussion of adjustment for optimization of any preferred or desirable levels of gain. Furthermore, there is no discussion of the variability of the switchable transimpedance element from initial fixed levels to accommodate any optimization efforts. As such, Ewen fails to disclose or suggest each and every element of the claimed invention.

Yet, the Office Action continues, “it would have been obvious ... to have optimized at least one of the two gain values for maximum sensitivity, *since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.*” *Id.* at 2 (citing *In re Aller*, 220 F.2d 454, 105 U.S.P.Q. 233 (CCPA 1955), emphasis added). The Office Action also attempts to rely on *In re Boesch*, 617 F.2d 272, 205 U.S.P.Q. 215 (CCPA 1980). However, reliance on *In re Aller* and *In re Boesch* is misplaced in this case, and in contradiction to the law and the M.P.E.P.

In the present case, the mere fact that routine skill is required does not, alone, make the modification obvious. *See, e.g.*, M.P.E.P. § 2143.01(III-IV). Ewen not only fails to disclose or suggest each and every element of the claimed invention, Ewen also contains no suggestion or motivation to modify Ewen as claimed. *See Ex Parte Sullivan*, 2003 WL 23014513 (Bd.Pat.App & Interf. 2003) (NO. APL 2002-0109, APP 09/110,221) (Rejecting Examiner’s reliance on *In re Aller* absent a suggestion or motivation to modify the reference as claimed). As discussed

above, Ewen simply contains no discussion of adjustment for optimization, and no discussion of the variability of the switchable transimpedance element to accommodate any optimization efforts. Since “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references,” M.P.E.P. § 2143.01, the basis for the suggested modification of Ewen as proposed in the Office Action is improper.

For at least these reasons, claim 17 is in condition for allowance. Claims 18-30 are allowable at least for their dependence on an allowable independent claim.

With respect to claim 31, the Office Action admits that “Ewen differs from the claimed invention in that Ewen fails to specifically teach determining the gain value in accordance with [the] equation.” *Office Action* at 5. The Office Action attempts to correct this deficiency by alleging that “there being no physical difference between the device of Ewen and that of the claimed invention, it is clear that one skilled in the art could have determined the gain value in accordance with the equation claimed.” *Id.* First, Applicant does not agree that there is no physical difference between the device of Ewen and the presently claimed invention. Second, even in there were no physical difference, there is no teaching, suggestion, or motivation *in the prior art of record* to support the allegation that the equation could have been used. Simply stating that a modification could have been done, does not meet the *prima facie* burden. “Broad conclusory statements standing alone are not ‘evidence.’” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *see also* M.P.E.P. § 2143.01. Since Ewen fails to disclose the equation, Ewen cannot suggest the use of the equation to one of skill in the art as required to establish a *prima facie* case of obviousness. The Office Action has not identified any prior art references as being obvious to combine with the teachings of Ewen. In short, the Office Action failed to supply any evidence to support its broad conclusory statements, and as such, failed to establish a *prima facie* case of obviousness.

Additionally, it appears that the Office Action may be attempting to rely on the disclosure of the present invention as a basis for arguing that claim 31 is obvious. *See* Office Action at 5-6. Of course, any attempt to rely on Applicant’s disclosure in an obviousness rejection is simply improper. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.” M.P.E.P. § 2143, (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

With respect to claim 33, the Office Action admits that “Ewen differs from the claimed invention in that Ewen fails to specifically teach a package for packaging said optical reception

device and said amplifier.” *Office Action* at 4. The Office Action attempts to correct this deficiency by alleging that “the claimed packages are standardized and readily available. One ... would clearly have recognized that the system of Ewen could have easily been implemented in any of the packages claimed.” *Id.* Even if, *arguendo*, the packages are standardized, there is no teaching, suggestion, or motivation *in the prior art of record* to support the allegation that the they could have been used. Simply stating that a modification could have been done, does not meet the *prima facie* burden. “Broad conclusory statements standing alone are not ‘evidence.’” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Since Ewen fails to disclose the equation, Ewen cannot suggest the use of the equation to one of skill in the art as required to establish a *prima facie* case of obviousness. The Examiner has not identified any references or other materials as being obvious to combine with the teachings of Ewen. In short, the Office Action failed to supply any evidence to support its broad conclusory statements, and as such, failed to establish a *prima facie* case of obviousness. For at least these reasons, claims 31 and 33 are in condition for allowance.

Additionally, because there is no disclosure of the equation of claim 31 or package of claim 33, Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 31 and 33. Particularly, the Examiner has simply stated that “it is clear that one skilled in the art could have determined the gain value in accordance with the equation claimed,” and “ and the Examiner has not identified any references or other materials as being obvious to combine with the purported teachings of Ewen. *See, e.g.*, M.P.E.P. §§ 2144.03 In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 31 and 33 are based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 31 and 33.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. The Examiner is encouraged to contact the undersigned if the Examiner believes that a telephone interview or Examiner's amendment will further the prosecution of this application.

Respectfully submitted,  
WORKMAN NYDEGGER

Dated: October 2, 2006

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